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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/686,154

10/15/2003

Thomas W. Davison

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CROMPTON, SEAGER & TUFTE, LLC

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SUITE 800

MINNEAPOLIS, MN 55403-2420

EXAMINER

BUI, VY Q

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/686,154	<b>Applicant(s)</b> DAVISON, THOMAS W.	
	<b>Examiner</b> Vy Q. Bui	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 69-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

Election of the invention as recited in claims 1-68 was made **without** traverse in the reply filed on 3/19/2007.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

At least claims 1-10, 13-20, 23-34, 37-42, 44-46, 49-52, 54-56, 59-62 and 64-68 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1, 3, 14, 20, 33 of U.S. Patent No. 6,361,488. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claims same main structural limitations such as an elongate body/cannula having a passage/channel, support arm/1<sup>st</sup> support and 2<sup>nd</sup> support, viewing device/viewing element.

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Applicant argued that the present invention claims an elongate body having a greater cross-sectional area at distal end than that of a proximal end (Remarks, paper 9/4/2007, page 17 of 21). However, an elongate body having a greater cross-sectional area at distal end than that of a proximal end is well-known in the art and therefore is not the main subject matter for patentable weight, for example, see elongate body combined of elements 42 and 91 as shown in Fig. 1-3 of Cohen-6,712,795.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-10, 13-20, 23-34, 37-42, 44-46, 49-52, 54-56, 59-62 and 64-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Graber et al.-5,370,647.

As to claims 1-10, 13-20, 23-34, 37-42, 44-46, 49-52, 54-56, 59-62 and 64-68, Graber-'647 (Fig. 1-9, col. 6, line 14-28, for example) discloses retractor 10 including tubular elongate body 30, expandable/enlargeable distal end 50, support arm/cannula 4 coupled to cannula 5 (Fig. 4) for receiving an endoscope/laparoscope to view a surgery site inside a body and a camera for producing image on a television screen substantially as recited in the claims. Notice that the Graber-'647 system is used in a location near to the spine of a patient.

In response to the applicant's amendment, the below are reasons for maintaining the rejection in the previous rejection (paper 5/8/2007):

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As to claim 1, Graber-'647 (Fig. 1-3) shows flexible wires 39 expandable to provide rigidity for the distal end 50 to access a surgical location.

As to claim 13, Graber-'647 (Fig. 1-4) shows handle 20 of elongate body 30 and set screw 8 or 9 of support arm 4 as a adjustment mechanism for a user to manually moving the elongate body relative to the support arm.

As to claim 23, Graber-'647's support arm 4 extends as recited in the claim because arm 4 is a 3-dimensioned structure.

As to claim 26, 2<sup>nd</sup> support arm 5 is coupled to (formed a pair to or combined to) 1<sup>st</sup> support arm 4 as recited in the claim to facilitate the medical procedure.

As to claims 37, 40-41 and 43, Graber-'647's support arm 4 supports elongate body 10 and supports (assists) additional viewing device in a medical procedure. The viewing device includes a handle as an adjustment mechanism for moving the viewing device in a motion generally parallel to a longitudinal axis of the elongate body as recited in the claims.

As to claim 62, a viewing device is considered as operably coupled with the elongate body because the viewing device and the elongate body are operable and used together in a medical operation.

2. Claims 26, 27, 30-31, 37, 40-41 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Bonutti.-5,197,971.

As to claims 26, 27, 30-31, 37, 40-41 and 43, Bonutti-'971 (Fig. 7-8, for example) shows 1<sup>st</sup> support arm 20, 2<sup>nd</sup> support arm 30 for supporting a viewing device as recited in the claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-12, 21-22, 35-36, 43, 47-48, 53, 57-58 and 63 are rejected under 35 U.S.C.

103(a) as being unpatentable over Graber et al.-5,370,647.

As to claims 11-12, 21-22, 35-36, 47-48 and 57-58, Graber-'647 (Fig. 1-9, col. 6, line 14-28, for example) discloses substantially the claimed invention, except for using a magnifying glass or a microscope for viewing. However, as stated in the application, it would have been obvious to one of ordinary skill in the art to provide a magnifying glass or a microscope for viewing the surgical site as a magnifying glass or a microscope is well known and well recognized device for enhancing a viewing of a surgical site.

***Response to Arguments***

Applicant's arguments filed 9/4/2007 have been fully considered but they are not persuasive.

The claims do not provide any structural limitation to distinguish the claimed invention over the prior art references as indicated in the rejection above. Therefore, the claims have been rejected.

***Conclusion***

The "Final Rejection" (paper 5/22/2008) has been withdrawn. This "Non-Final Rejection" begins the reopening of the prosecution of this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vy Q. Bui/

Primary Examiner, Art Unit 3773